

**REMARKS**

After entry of this Amendment, claims 1-15 will be all the claims pending in the application. Claims 1, 4, 5, and 7-11 have been amended. Support for the amendments may be found in the specification, e.g., at page 7, lines 8-13.

No new matter has been added.

Entry of the above amendments is respectfully requested.

**I. Claim Rejections - 35 U.S.C. § 112**

(A) On page 2 of the Office Action, claims 1-15 are rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement.

In response, and while not admitting that the rejection is appropriate, claims 1, 4, 5, and 7-11 have been amended to delete the recitation of “inositol derivative.” Additionally, claims 1, 5 and 9-11 have been further amended to delete the recitation of the inositol combined with a saccharide and inserting the phrase “compound produced by reacting an inositol with a saccharide.” Applicants respectfully submit that since the inositol derivative of the present invention is a compound resulting from the reaction of an inositol with a saccharide, the specification, including the exemplified compounds, adequately supports the presently claimed invention.

Withdrawal of the rejection is respectfully requested.

(B) On page 5 of the Office Action, claims 1-15 are rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite.

With regard to claims 1 and 3 (and the claims dependent thereon), Applicants respectfully submit that the amendment to the claims as discussed above in section I(A), as well as the fact that the constitutional unit is clearly a unit which is used to constitute (form) the monosaccharide and/or the oligosaccharide, overcomes the rejection.

Withdrawal of the rejection is respectfully requested.

**II. Claim Rejections - 35 U.S.C. § 102**

On page 6 of the Office Action, claims 1-3, 5-6, 9-10, 12-13 and 15 are rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Jain (U.S. Patent Publication 2003/0068297).

Applicants respectfully submit that Jain discloses a composition containing the mixture of D-glucose and inositol. On the other hand, present claim 1 recites an external preparation comprising a compound produced from the reaction of an inositol with a saccharide. Therefore, Applicants respectfully submit that Jain does not anticipate present claim 1 because Jain does not teach or suggest each and every limitation of present claim 1.

Also, Applicants submit that claims 2-3, 5-6, 9-10, 12-13 and 15 are at least patentable over Jain by virtue of their dependency from claim 1.

Withdrawal of the rejection is respectfully requested.

**III. Claim Rejections - 35 U.S.C. § 103**

(A) On page 8 of the Office Action, claims 4, 7-8, 11 and 14 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Jain in view of Minami et al. (JP-10-114614).

Applicants respectfully submit that Minami et al. discloses a cosmetic product containing inositol. On the other hand, present claim 1 recites an external preparation comprising a compound produced from the reaction of an inositol with a saccharide.

Therefore, Applicants submit that Minami et al. does not make up for the deficiencies of Jain as applied to present claim 1, and thus a *prima facie* case of obviousness has not been made because the cited references do not teach each and every element of present claim 1.

Thus, Applicants submit that claims 4, 7-8, 11 and 14 are at least patentable over Jain and Minami et al. by virtue of their dependency from claim 1.

Withdrawal of the rejection is respectfully requested.

(B) On page 9 of the Office Action, claims 1-3, 5 and 9-10 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Sleevi et al. (U.S. Patent No. 6,492,339).

Applicants submit that Sleevi et al. discloses a composition containing the mixture (polysaccharides) of inositol and additional sugars. On the other hand, present claim 1 recites an external preparation comprising a compound produced from the reaction of an inositol with a saccharide.

Therefore, Applicants submit that a *prima facie* case of obviousness has not been made because Sleevi et al. do not teach each and every element of claim 1.

Also, Applicants submit that claims 2-3, 5 and 9-10 are at least patentable over Sleevi et al. by virtue of their dependency from claim 1.

Withdrawal of the rejection is respectfully requested.

(C) On page 12 of the Office Action, claims 1-15 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Lamothe et al. (U.S. Patent No. 5,518,733) in view of Satou et al. (JP 63196596). Applicants traverse the rejection for the following reasons.

First, Applicants submit that the technical field of Lamothe et al. is quite different from that of Satou et al. Lamothe et al. is directed to cosmetic compositions comprising oligosaccharides that promote the development of bacterium strains that constitute a major portion of the skin or vaginal flora. *See*, column 1, lines 24-27. On the other hand, the gluco-oligosaccharides having an inositol of Satou et al. are directed to the growth promotion of *Bifidobacterium*, a major genera of anaerobic bacteria that make up the gut flora, that reside in the colon. *See*, the first full paragraph on page 15 of the translation of Satou et al.

Therefore, Applicants submit that one of ordinary skill in the art would not have a reason to use the gluco-oligosaccharides having an inositol of Satou et al. with the cosmetic compositions of Lamothe et al. because the bacterium benefited by the compound of Satou et al. make up a completely different flora compared to those benefited by the cosmetic compositions of Lamothe et al. Accordingly, Applicants submit that a *prima facie* of obviousness has not been made because a skilled artisan would not have a reason to combine the cosmetic compositions of Lamothe et al. with the gluco-oligosaccharides having an inositol of Satou et al. with a reasonable expectation of success.

Next, Applicants submit that Lamothe et al. disclose specific oligosaccharides that are useful to the development of beneficial bacterial strains for the skin and the vaginal flora. On the other hand, according to Satou et al., the inositol-oligosaccharides are useful for promoting the

growth of *Bifidobacterium*, because these inositol-oligosaccharides are indigestible and can reach the colon. Further, Satou et al. disclose that the inositol-oligosaccharides are consumed in the colon so as to promote the growth of *Bifidobacterium*. Applicants submit that this fact raises the possibility of the consumption of these inositol-oligosaccharides by other strains of bacteria, including non-beneficial strains.

Accordingly, Applicants submit that a skilled artisan would not have a reason to believe that the indigestible inositol-oligosaccharides would be useful for the development of beneficial strains of the skin and the vaginal flora, and thus would not have a reason to combine the teachings of Lamothe et al. with the teachings of Satou et al. to arrive at the invention recited in claim 1, and thus, a *prima facie* case of obviousness has not been made.

Also, Applicants submit that claims 2-15 are at least patentable over the cited documents by virtue of their dependency from claim 1.

Withdrawal of the rejection is respectfully requested.

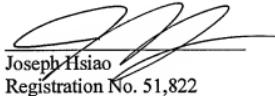
In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

AMENDMENT UNDER 37 C.F.R. § 1.111  
U.S. Appln. No.: 10/594,037

Attorney Docket No.: Q80830

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



Joseph Hsiao  
Registration No. 51,822

SUGHRUE MION, PLLC  
Telephone: (202) 293-7060  
Facsimile: (202) 293-7860

WASHINGTON OFFICE

23373

CUSTOMER NUMBER

Date: March 23, 2009